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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

6

DATE MAILED: 06/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,920

Applicant(s)

TANAKA et al

Examiner

J. DOTE

Group Art Unit

1756

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4/15/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-4, 6, 8-20 is/are pending in the application.
- Of the above claim(s) 12-20 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-4, 6, 8-11 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

1. The examiner acknowledges the cancellation of claims 5 and 7 and the amendments to claims 1, 6, 8, 10, and 11 filed in Paper No. 5 on Apr. 15, 2002 (cert. mail. Apr. 5, 2002). Claims 1-4, 6, and 8-20 are pending.

The clean copy of amended claim 8 filed in Paper No. 5 is not same as the marked-up version of claim 8. The clean copy of claim 8 recites the phrase "compound has a biphenyl group which may have at least one substituent group" (emphasis added). The marked-up version of claim 8 recites the phrase "compound have a biphenyl group which may has at least one substituent group" (emphasis added). Since the clean copy of amended claim 8 automatically deletes the previously filed claim 8, the clean copy of amended claim 8 has been entered.

2. Applicants' election of the invention in Group I, claims 1-11 in Paper No. 5 is acknowledged. Because applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 12-20 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 5.

3. The objections to the specification set forth in the Office action mailed on Dec. 5, 2001, Paper No. 4, paragraphs 5 and 6, have been withdrawn in response to the replacement paragraph at page 8 of the specification filed in Paper No. 5, and the cancellation of claim 5.

The rejection of claim 6 under 35 U.S.C. 112, second paragraph, set forth in Paper No. 4, paragraph 8, has been withdrawn in response to the amendment to claim 6.

The objection to claim 8 set forth in Paper No. 4, paragraph 9, has been withdrawn in response to the filing of the clean copy of claim 8 in Paper No. 5.

4. The amendment filed in Paper No. 5 on Apr. 15, 2002, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The replacement paragraph at page 8, line 15, of the specification, replaces formula (4) at page 9, line 1, where the group R^{15} is attached at the meta-position of the phenyl ring, with amended formula (4), where a line runs from group R^{15} to the center of the phenyl ring, indicating that the group R^{15} can be bonded to the ortho, meta, and para positions of the phenyl ring.

The originally filed specification does not provide an adequate written description of said amendment to formula (4). As discussed above, the originally filed specification at page 9, line 1, shows that the R^{15} is attached at the meta-position of the phenyl ring. The originally filed specification does not disclose any compounds of formula (4) where the group R^{15} is positioned at the para or ortho positions of the phenyl ring.

Applicants are required to cancel the new matter in the reply to this Office Action.

Applicants' arguments filed in Paper No. 5 have been fully considered but they are not persuasive. Applicants argue that the amendment to formula (4) corrects a typographic error. Applicants assert that support for the amendment is found in compounds CT-1, CT-2, CT-9, and CT-10 listed on page 14, which have methyl groups in the para position. Applicants state that in compound CT-2, the methyl groups are in both meta- and ortho-positions.

Applicants' arguments are not persuasive. Contrary to applicants, compounds CT-1, CT-2, CT-9, and CT-10 are not within the limitations of originally filed formula (4) or of amended formula (4). The specification at page 9, lines 2-3, states that the group R^{15} is either a H atom, an alkyl or an alkoxy group, which may have a substituent group, or a halogen. In compounds CT-9 and CT-10, one of the phenyl groups is substituted with

-CH=C- group, which is outside the Markush group disclosed at page 9. In addition, both formulas (4) only show that each of three phenyl rings are substituted with only one R group. Compounds CT-1 and CT-2 contain phenyl groups substituted with two methyl groups. (Contrary to applicants, the phenyl ring in compound CT-2 is substituted with methyl groups at the meta- and para- positions of the ring, not the ortho- and para- positions alleged by applicants.) Accordingly, the objection to the specification stands.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 6 recites a triarylamine compound represented by formula (4) wherein a line runs from group R^{15} to the center of the phenyl ring, indicating that the group R^{15} can be bonded to

the ortho, meta, and para positions of the phenyl ring. The originally filed specification does not provide an adequate written description of formula (4). The originally filed specification at page 9, line 1, discloses that the group R¹⁵ of formula (4) is attached at the meta-position of the phenyl ring. The originally filed specification does not disclose any compounds of formula (4) where the group R¹⁵ is positioned at the para or ortho positions of the phenyl ring.

For the reasons discussed in paragraph 4 above, which are incorporated herein by reference, applicants' arguments with respect to the position of group R¹⁵ in formula (4) are not persuasive.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f), or (g) prior art under 35 U.S.C. 103(a).

8. The phrase "at least one of Ar¹ to Ar³ is a tert-butyl group" recited in instant claim 1 is interpreted to mean that one of the Ar groups is tert-butyl, which is an alkyl group. See the instant specification, page 10, lines 4-5, and the compounds listed at page 11.

9. Claims 1-4, 8, and 9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6,228,547 B1 (Kobayashi).

Kobayashi discloses an electrophotographic photosensitive member comprising an electrically conductive substrate and a photosensitive layer comprising a charge generation material and the charge transfer material bis(3',4'-methylenedioxy-phenyl-N-2"-naphthylamino)benzene, compound 21. Compound 21 is within the limitation of the triarylamine compound recited in instant claim 1. See compound 21 at col. 9; Table 2, application example 5; and col. 34, lines 21-33.

Instant claims 1-4, 8, and 9 are written in product-by-process format. These claims recite that the triarylamine compound is obtained in the presence of a catalyst comprising a particular phosphine compound containing a "tert-butyl" group. Kobayashi does not disclose that triarylamine compound 21 is obtained by a catalyst comprising the phosphine compound recited in the instant claims. Kobayashi's compound 21 is synthesized by

a method that is within the method limitations recited in the instant claims, but for the particular phosphine compound recited in the instant claims. Kobayashi's compound 21 is obtained by reacting the amine compound N,N'-di-2-naphthyl-m-phenylenediamine with the aryl halide compound 3,4-methylene-dioxybromobenzene in the presence of the base sodium tert-butoxide and a catalyst comprising a palladium compound and the triarylphosphine compound tri-o-tolylphosphine. Example 9 at col. 32, lines 33-48. The instant specification contains no teachings that the triarylamines made by methods using the particular phosphines recited in the instant claims are different from those made by methods using a triarylphosphine compound not comprising a t-butyl group, such as tri-o-tolylphosphine taught by Kobayashi. See the instant specification, formula (1) at pages 7 and 8, and Table 1, synthetic example 10, which uses triphenylphosphine. Formula (1) of the instant specification states that the phosphine compound of formula (1) can be substituted with aryl groups, which may have substituent groups. Table 1 shows that the triarylamine compound of synthetic example 10 has the same purity as triarylamine compounds obtained using phosphines comprising a tert-butyl group. Table 4 of the instant specification shows that a photosensitive member comprising the triarylamine compound of synthetic example 10 provides results that are the same as or better than the results provided by

photosensitive members comprising triarylamine compounds obtained using phosphine compounds comprising a tert-butyl group.

Accordingly, it appears that Kobayashi's triarylamine compound 21 is the same or substantially the same as the instantly recited triarylamine compound made by the methods using the particular phosphine compounds recited in the instant claims. The burden is on applicants to prove otherwise. In re Marosi, 218 USPQ 289 (Fed. Cir. 1983); In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985); MPEP 2113.

10. Claims 1-4, 8, and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent 5-78261 (JP'261), as evidenced by the Japanese Patent Office (JPO) machine-assisted translation of JP'261.

JP'261 discloses an electrophotographic photosensitive member comprising an electrically conductive substrate and a photosensitive layer comprising a charge generation material and the charge transfer material triarylamine compound. See JP'261, compounds 12, 40, 65, 71, and 96; and the JPO translation, examples 1 and 2 at paragraphs 0115, 0117, and 0118. JP'261's triarylamine compounds are within the limitation of the triarylamine compound recited in instant claim 1.

Instant claims 1-4, 8, and 9 are written in product-by-process format. The instant claims recite that the triarylamine compound is obtained in the presence of a catalyst comprising a particular phosphine compound. Instant claims 3 and 4 recite that the triarylamine is obtained in the presence of the base alkali metal alkoxide [claim 4: sodium tert-butoxide]. JP'261 does not disclose that its triarylamine compounds are obtained by a catalyst comprising the phosphine compound recited in the instant claims. Nor does JP'261 disclose that the base used in its reaction is an alkali metal alkoxide. However, JP'261's triarylamine compounds are synthesized by a method that is within the method limitations recited in the instant claims, but for the particular phosphine compound recited in the instant claims and the particular base recited in instant claims 3 and 4. JP'261's compounds are obtained by reacting an aminostyrene compound with a trihalobenzene compound in the presence of a base such as tributylamine and a catalyst comprising a palladium compound and a triarylphosphine compound. JPO translation, paragraphs 0008-0016, and example 5 at paragraph 0113. JP'261 discloses that the triarylphosphine can be triphenylphosphine, tri-o-tolylphosphine, or tris-(2-methyl-5-t-butylphenyl)phosphine. JPO translation, paragraph 0013. Example 5 exemplifies making the triarylamine compound 1,2,4-tris(beta(p-N,N-diphenylamino styryl))benzene, compound 40, using tri-o-

tolylphosphine. The instant specification contains no teachings that the triarylamine made by methods using the particular phosphines recited in the instant claims are different from those methods using a triarylphosphine compound not comprising a t-butyl group, such as tri-o-tolylphosphine or tris-(2-methyl-5-t-butylphenyl)phosphine taught by JP'261. The discussion of the instant specification in paragraph 9 above is incorporated herein by reference. In addition, there are no teachings in the instant specification that the triarylamine made by methods using an alkali metal alkoxide base as recited in instant claims 3 and 4 are different from those methods using other bases. See the instant specification at page 12, lines 18-19, which discloses that "the base may be selected from inorganic and/or organic bases without limitation." Accordingly, it appears that JP'261's triarylamine compounds are the same or substantially the same as the instantly recited triarylamine compound made by the methods using the particular phosphine compounds recited in the instant claims, or by particular bases recited in instant claims 3 and 4. The burden is on applicants to prove otherwise. Marosi, supra; Thorpe, supra; MPEP 2113.

11. Claims 1-4, 8, and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 4,920,022 (Sakakibara).

Sakakibara discloses an electrophotographic photosensitive member comprising a charge generation material, and the charge transfer triarylamine compound I-2. Col. 3, line 2, and the first and second tables at col. 33, example 3.

Instant claims 1-5 and 7-9 are written in product-by-process format. These claims recite that the charge transfer triarylamine is obtained by reacting an amine compound with an aryl halide in the presence of the base and a catalyst comprising a palladium compound and a particular phosphine compound. Sakakibara does not disclose that his triarylamine compound I-2 is obtained by such a method. Sakakibara, col. 11, line 34, to col. 12, line 46. The instant specification discloses that when the charge transfer triarylamine compound is made by the method recited in instant claim 1, the photosensitive member comprising the resulting charge transfer compound exhibits an endurance stability. Instant specification, page 5, lines 14-16, page 5, line 23, to page 6, line 9, and Table 4, examples 1-10. For example, Table 4 reports that after 30,000 copying operations, the photosensitive member in example 3 exhibited a variation in dark potential and light potential variation of -5 V and -15 V, respectively. Sakakibara also discloses that his electrophotographic photosensitive member comprising the charge transfer triarylamine compound I-2 has excellent durability to the repetition of the image forming process. Col. 2,

lines 16-19, and the second table at col. 33, example 3. The second table reports that after 50,000 successive image formation cycles, the variation in the dark potential and light potential were -10 V and 0 V, respectively. Accordingly, it appears that Sakakibara's triarylamine compound I-2 is the same or substantially the same as the instantly recited triarylamine compound made by the method recited in the instant claims. The burden is on applicants to prove otherwise. Marosi, supra; Thorpe, supra; MPEP 2113.

12. The following terms are means-plus-function limitations covered by the 35 U.S.C. 112, sixth paragraph: "exposure means," "developing means," "transfer means," and "cleaning means" recited in instant claims 10 and 11. The only definitions are provided by instant Fig. 1 and equivalence thereof. The instant specification at page 19, lines 16-18, discloses that the term "primary charging means" may use a charge roller. However, based on the disclosure at page 19, lines 11-18, the specification does not limit the primary charging means to a contact roller. The specification at page 19, states that "[w]hen the primary charging means 3 is a contact charge means using a charge roller, preexposure is not always necessary."

13. Claims 1-4, 6, 8-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,098,809 (Kikuchi).

Kikuchi discloses an electrophotographic photosensitive member comprising a charge generation material, and the charge transfer triarylamine compound 10 that meets the limitations of formula (2) recited in instant claim 6. Col. 4, line 60, and example 1 at cols. 10-11. Kikuchi further discloses that said photosensitive member can be used in an electrophotographic process cartridge or apparatus that both comprise the other components recited in instant claims 10 and 11. See Fig. 2 and col. 10, lines 1-59. Kikuchi's apparatus shown in Fig. 2 contains the same symbols identifying the various "means" as shown in the apparatus of instant Fig. 1, but for the "charging means." Kikuchi discloses that his charging means provides uniform charge on the photosensitive member and includes corona charges. Col. 10, lines 40-41. Kikuchi's charging means provides the same function as the "charging means" recited in instant claims 10 and 11. As noted in paragraph 12 above, the definition of charging means recited in the instant specification does not exclude the corona charger disclosed by Kikuchi. Thus, Kikuchi's charging means is within the scope of the charging means recited in instant claims 10 and 11.

Instant claims 1-4, 6, and 8-11 are written in product-by-process format. These claims recite that the charge transfer triarylamine is obtained by reacting an amine compound with an aryl halide in the presence of the base and a catalyst comprising a palladium compound and a particular phosphine compound. Kikuchi does not disclose that his triarylamine compound 10 is obtained by such a method. Kikuchi, col. 7, lines 29-42. The instant specification discloses that when the charge transfer triarylamine compound is made by the method recited in instant claim 1, the photosensitive member comprising the resulting charge transfer compound exhibits an endurance stability. The discussion of the instant specification in paragraph 11 above is incorporated herein by reference. Kikuchi also discloses that his electrophotographic photosensitive member comprising the charge transfer triarylamine compound 10 has excellent durability to the repetition of the image forming process. Col. 2, lines 20-24, and Table 1, example 1. Table 1 reports that after 10,000 successive image formation cycles, the variation in the dark potential and light potential were -3 V and -4 V, respectively. Accordingly, it appears that Kikuchi's triarylamine compound 10 is the same or substantially the same as the instantly recited triarylamine compound made by the method recited in instant claims 1-11. The burden is on applicants to prove otherwise. Marosi, supra; Thorpe, supra; MPEP 2113.

14. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,430,526 (Ohkubo) combined with Kobayashi.

Ohkubo discloses an electrophotographic image forming apparatus comprising all the components recited in instant claim 11, but for the particular photosensitive member. Fig. 1, col. 2, line 56, to col. 3, line 56. Ohkubo also discloses a process cartridge which comprises all the components recited in instant claim 10, but for the particular photosensitive member. Fig. 2, col. 3, line 65, to col. 4, line 8. Ohkubo's discloses that the charging member is a contact charging roller as recited in the instant claims. An oscillating voltage is applied to the charging roller in the form of a DC-biased AC voltage. The peak-to-peak voltage of the oscillating voltage is not less than twice the absolute value of a "charge starting voltage" relative to the photosensitive member. Said oscillating voltage provides uniform charging. Ohkubo discloses that "uneven charging hardly occurs in a regular developer or a reverse development process." Col. 1, lines 36-42, col. 3, line 64, to col. 4, line 5, col. 4, lines 9-17.

Ohkubo does not disclose the use of the photosensitive member recited in the instant claims. However, Ohkubo does not limit the type of photosensitive member used. Col. 4, lines 29-35.

Kobayashi discloses an electrophotographic photosensitive member that appears to meet the photosensitive member limitations recited in instant claims 10 and 11. The discussion of Kobayashi in paragraph 9 above is incorporated herein by reference. Kobayashi further discloses that the conductive substrate of the photosensitive member can be a drum. Col. 21, lines 46-48. Kobayashi discloses that his photosensitive member is a high-performance photosensitive member that exhibits a high carrier mobility, a high sensitivity, and low residual potential. Col. 3, lines 1-6, and col. 55, lines 44-55, and Table 2, application example 5. Kobayashi discloses that high performance photosensitive members are capable of copying at a higher printing speed. Col. 1, lines 44-49.

It would have been obvious for a person having ordinary skill in the art, in view of the teachings of Kobayashi, to use Kobayashi's photosensitive member as the photosensitive member in the apparatus and process cartridge disclosed by Ohkubo, because that person would have had a reasonable expectation of successfully obtaining an electrophotographic apparatus and process cartridge capable of providing copies at a high printing speed.

15. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkubo combined with JP'261, as evidenced the JPO translation of JP'261.

Ohkubo discloses an electrophotographic image forming apparatus comprising all the components recited in instant claim 11, but for the particular photosensitive member. Ohkubo also discloses a process cartridge which comprises all the components recited in instant claim 10, but for the particular photosensitive member. The discussion of Ohkubo in paragraph 14 above is incorporated herein by reference.

Ohkubo does not disclose the use of the photosensitive member recited in the instant claims. However, Ohkubo does not limit the type of photosensitive member used. Col. 4, lines 29-35.

JP'261, as evidenced by the JPO translation of JP'261, discloses an electrophotographic photosensitive member that appears to meet the photosensitive member limitations recited in instant claims 10 and 11. The discussion of JP'261 in paragraph 10 above is incorporated herein by reference. JP'261 further discloses that its triarylamine compounds have high purity. JPO translation, paragraph 0018. JP'261 discloses that photosensitive members comprising said triarylamine compounds have high sensitivity and a low residual potential. JPO translation, paragraphs 0018, 0115 and 0117-0119.

It would have been obvious for a person having ordinary skill in the art, in view of the teachings of JP'261, to use JP'261's photosensitive member as the photosensitive member in the apparatus and process cartridge disclosed by Ohkubo, because that person would have had a reasonable expectation of successfully obtaining an electrophotographic apparatus and process cartridge having high sensitivity and low residual potential.

16. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkubo combined with Sakakibara.

Ohkubo discloses an electrophotographic image forming apparatus comprising all the components recited in instant claim 11, but for the particular photosensitive member. Ohkubo also discloses a process cartridge which comprises all the components recited in instant claim 10, but for the particular photosensitive member. The discussion of Ohkubo in paragraph 14 above is incorporated herein by reference.

Ohkubo does not disclose the use of the photosensitive member recited in the instant claims. However, Ohkubo does not limit the type of photosensitive member used. Col. 4, lines 29-35.

Sakakibara discloses an electrophotographic photosensitive member as described in paragraph 11 above, which is incorporated

herein by reference. As discussed in paragraph 11, Sakakibara discloses that its photosensitive member has excellent durability after many repeated image formations.

It would have been obvious for a person having ordinary skill in the art, in view of the teachings of Sakakibara, to use Sakakibara's photosensitive member as the photosensitive member in the apparatus and process cartridge disclosed by Ohkubo, because that person would have had a reasonable expectation of successfully obtaining an electrophotographic apparatus and process cartridge having excellent durability to repeated image formation.

17. Applicants' arguments filed in Paper No. 5 with respect to the rejections set forth in paragraphs 9-11 and 13-16 above have been fully considered but they are not persuasive.

(1) Rejections over Kobayashi and JP'261.

Applicants argue that both Kobayashi and JP'261 use a tri-ortho-tolyl phosphine compound, not a phosphine compound containing a t-butyl group as recited in the instant claims. Applicants argue that both Kobayashi and JP'261 do not show that the photosensitive member comprising their respective triarylamine compounds compound have satisfactory electrophotographic characteristics after extended use using a contact charging method as used in the present invention.

Applicants assert that "in the absence of data, one can merely speculate whether such a Kobayashi catalyst [or JP'261's catalyst] would be satisfactory in providing a charge transfer material with high purity resulting in good endurance characteristics" as shown by applicants using a phosphine compound comprising a tert-butyl group as recited in the instant claims.

Applicants' arguments are not persuasive for the following reasons:

- Instant claims 1-4, 8, and 9 do not recite a charge-contacting method. Rather, the instant claims are drawn to a photosensitive member. Applicants cannot argue patentability based on limitations that are not present in the claims. With respect to instant claims 10 and 11, as discussed in paragraph 14 above, Ohkubo teaches an apparatus and process cartridge that comprises all the other components (which include a contact charger) recited in instant claims 10 and 11. For the reasons set forth in paragraphs 14 and 15, the combined teachings of Ohkubo with either Kobayashi or JP'261 render obvious the process cartridge and apparatus recited in instant claims 10 and 11, respectively.

- There is no objective evidence in the present record supporting applicants' allegation that the results provided by applicants' triarylamine compounds made by the method recited in

the instant claims reported in Table 4 of the instant specification are obtained by a system using a contact charging method. The instant specification merely discloses that a laser beam printer LBP-950 made by Cannon is used to determine the results in "Table 3 [sic: 4]."

- Applicants have not provided any objective evidence to show that Kobayashi's triarylamine compound 21 or the triarylamine compounds disclosed by JP'261 are not the same or substantially the same as the triarylamine compounds made by using phosphine compounds comprising a tert-butyl group as recited in the instant claims. As discussed in the rejection in paragraph 9 above, the instant specification shows that a photosensitive member comprising the triarylamine compound obtained by using a catalyst comprising triphenylphosphine provides electrophotographic properties after extended use that are the same as or better than the properties provided by photosensitive members comprising triarylamine compounds made by using phosphine compounds comprising a tert-butyl group. The compound triphenylphosphine is similar to tri-o-tolylphosphine used by Kobayashi and JP'261, and to tris-(2-methyl-5-tert-butylphenyl)phosphine used by JP'261. In addition, as discussed in paragraph 10 above, JP'261 discloses that its triarylamine compounds have high purity, the same property sought by applicants. Thus, applicants have failed to meet their burden to

show that Kobayashi's compound 21 and JP'261's triarylamine compounds are not the same or substantially as the triarylamine compound made using the particular phosphine compound (catalyst component) recited in the instant claims.

Accordingly, the rejections over Kobayashi and the rejections over JP'261 stands.

(2) The rejections over Sakakibara.

Applicants argue that Sakakibara's triarylamine compound is not made by the process recited in the instant claims, but is obtained by the Ullmann reaction. Applicants argue that the instant specification shows that photosensitive members comprising triarylamine compounds (comparative examples 1-10) made by the Ullmann reaction provide poor results compared to photosensitive members comprising triarylamine compounds made by the process recited in the instant claims. Applicants argue that because Sakakibara uses an NP-150Z tester which employs a corona charge, not a contact charging member as employed in the present invention, "one cannot determine whether the resulting member would provide satisfactory performance under the severe conditions of contact charging of the present invention."

Applicants' arguments are not persuasive for the following reasons:

- Instant claims 1-4, 8, and 9 do not recite a charge-contacting method. Rather, the instant claims are drawn to a

photosensitive member. Applicants cannot argue patentability based on limitations that are not present in the claims. With respect to instant claims 10 and 11, as discussed above, Ohkubo teaches an apparatus and process cartridge that comprises all the other components (which include a contact charger) recited in instant claims 10 and 11. Thus, for the reasons set forth in paragraph 16 above, the combined teachings of Ohkubo with Sakakibara render obvious the process cartridge and apparatus recited in instant claims 10 and 11, respectively.

- As discussed supra, there is no objective evidence in the present record supporting applicants' allegation that the results shown in Table 4 of the instant specification are obtained by a system using a contact charging method.

- Applicants have not provided any objective evidence to show that Sakakibara's triarylamine compound I-2 is not the same or substantially the same as triarylamine compounds made by using phosphine compounds comprising a tert-butyl group as recited in the instant claims. The triarylamine compounds in comparative examples 1-10 are not a probative comparison to Sakakibara's compound I-2 because they are outside the scope of Sakakibara's invention. None of the triarylamine compounds in comparative examples 1-10 are within the limitations of formulas (1) and (2) disclosed at col. 2 of Sakakibara. There is no objective evidence supporting applicants' allegation that a photosensitive

member comprising Sakakibara's triarylamine compound I-2 does not provide satisfactory results using a contact charger. Thus, applicants have failed to show that Sakakibara's triarylamine compound I-2 is not the same or substantially the same as triarylamine compounds made by the method recited in the instant claims.

Accordingly, the rejections over Sakakibara stands.

(3) The rejection over Kikuchi.

Applicants argue that because Kikuchi is a patent assigned to the present assignee, they know that Kikuchi's triarylamine compound is obtained by the Ullmann reaction using a copper catalyst corresponding to the that used in comparative examples 1-10 of the instant specification. Applicants argue that because Kikuchi uses an NP-150Z tester, which employs a corona charge, not a contact charging member as employed in the present invention, "one cannot determine whether the resulting member would provide satisfactory performance under the severe conditions of contact charging of the present invention."

Applicants' arguments are not persuasive for the following reasons:

- Instant claims 1-4, 8, and 9 do not recite a charge-contacting method. Rather, the instant claims are drawn to a photosensitive member. Applicants cannot argue patentability based on limitations that are not present in the claims. Instant

claims 10 and 11 recite a "charging means." For the reasons discussed in paragraph 13 above, Kikuchi's charging means is within the scope of the charging means recited in instant claims 10 and 11.

- As noted supra, there is no objective evidence to support applicants' allegation that the results shown in Table 4 are obtained using a system comprising a contact charger.

- There is no objective evidence in the present record supporting applicants' allegation that Kikuchi's triarylamine compound is made by the Ullmann reaction. There is no disclosure in Kikuchi of how his compounds are obtained.

- Applicants have not provided any objective evidence to show that Kikuchi's triarylamine compounds are not the same or substantially the same as triarylamine compounds made by using phosphine compounds comprising a tert-butyl group as recited in the instant claims. Thus, applicants have failed to show that Kikuchi's triarylamine compounds are not the same or substantially the same as triarylamine compounds made by the method recited in the instant claims.

Accordingly, the rejection over Kikuchi stands.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (703) 308-3625. The examiner can normally be reached Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311 (Rightfax) for after final faxes, and (703) 872-9310 for other official faxes.

Any inquiry of papers not received regarding this communication or earlier communications, or of a general nature or relating to the status of this application or proceeding should be directed should be directed to the Customer Service Center of Technology Center 1700 whose telephone number is (703) 306-5665.

JLD
June 18, 2002

Janis L. Dote
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